

MAY 05 2011

In the United States Patent and Trademark Office

Appn. Number: 09/641,410
Appn. Filed: August 18, 2000
Applicant: Alice Mary O'Donnell Kiely
Title: Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards
Examiner/GAU: Keith Hendricks/Joyti Chawla 1794

Yorktown Heights, NY May 5, 2011

REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.181

Assistant Commissioner for Patents
Arlington, Virginia 22313
Office of Petitions
Attn: Mr. Brian Brown

Sir:

Applicant respectfully requests reconsideration for the withdrawal of the holding of abandonment for Application Serial Number 09/641,410, Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards.

Appn. Number 09/641,410 (Kiely)

GAU 1794

Request for Reconsideration

2

**Request for Reconsideration To Withdraw Holding of Abandonment
Based on Premature Final Office Action Under 37 CFR 1.181**

This correspondence is in regard to U.S. Patent Application Serial Number 09/641,410, Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards.

Applicant's Petitions to Withdraw the Holding of Abandonment of 3/29/2010, 12/16/2010, 12/29/2010 and 12/30/2010 are incorporated into this document by way of reference.

Applicant is currently in receipt of a decision on a Petition to Withdraw the Holding of Abandonment of this application. The decision is **DISMISSED** as moot.

The ground for this decision being:

As correctly noted by the Technology Center Director, the filing of an amendment after final rejection does not stop the running of the statutory period or reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Therefore, a Notice of Abandonment was mailed February 3, 2010. As the application is now abandoned, the petition to overturn the decision of the Technology center Director is DISMISSED as moot.

In response, Applicant disagrees and respectfully submits that Applicant's Request to Withdraw the Holding of Abandonment of Application SR No. 09/641,410 Edible Supports for Comestibles is not moot, but quite material.

In order for an "Abandonment" to be valid, Applicant had had to be sent a full and fair unbiased Office Action(s).

MPEP 706.07 - Thus examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing...)

Appn. Number 09/641,410 (Kiely)

GAU 1794

Request for Reconsideration

3

The record shows that both Office Actions of **10/16/2008** and **7/9/2009** were based solely upon prejudice and thus were not valid Office Actions.* Consequently, the finality of the Office Action is ineffectual and the said abandonment of the application is factually non-existent. [emphases added]

Accordingly, Application Serial No. 09/641,410 Edible Supports for Comestibles is thus NOT abandoned. Applicant further respectfully submits that as the decision of "DISMISSED as moot" was in response to Applicant's petitions which pointed out this documented prejudice, the decision, based upon this information, has thus compounded the noted prejudice.

Contrary to the Office, Applicant is NOT required to beg for a full and fair examination of claims 383 - 416 from the United States Patent and Trademark Office. [emphasis added]
(see at least MPEP 706.07 - Thus examiner should never lose sight of the fact that *in every case the applicant is entitled to a full and fair hearing...*), (35 U.S.C. 101 Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter...may obtain a patent therefor...), (35 USC 102, A person shall be entitled to a patent unless...by the other.)

Contrary to the Office, Applicant is NOT required to beg for the merits of claims 383 - 494 to be properly examined, which were stated to be understood by the Patent and Trademark Office. MPEP 707.07(j). (see Applicant's Petitions where the Office states: "*in fact since the edible support is disclosed as being a composite...*")

The Office furthermore has unlawfully withdrawn method and means claims (403 - 416) without a prima facie showing of being patentably distinct from claims 383 - 402. (35 U.S.C. Section 112 paragraph 6; 35 U.S.C. 101)

The Office has denied a patent to Applicant having patentable subject matter at least through continuous and intentional failure to consider the merits of claims 383 - 402 which were known to the Patent and Trademark Office, the unjust withdrawal of claims 403 - 416 from examination, and the repeated requirement for Applicant to cancel Applicant's patentable subject matter, as a

condition of the examination for a patent. (See petitions and Office Actions from the Office)
(MPEP 707.07(j))

* Office Action of 10/16/2008 stated:

1) Amendments to Specification:

The term "a composite material" as disclosed in the amendment would introduce new matter and change the description from "a candy bar" to "a composite material candy bar" in paragraph [0164] which is not the same as a generic term "candy bar" as originally described. Therefore, the amendments to the specification introduce new matter and the applicant is required to cancel the new matter in the reply to this Office Action.

2) 35 USC section 112, (first paragraph):

The term "composite material" as added to the claims introduces new matter as the term is not disclosed in the original disclosure and the introduction of the term "composite material" changes the description of "a candy bar" to "a composite material candy bar," which is not the same as a generic term "candy bar" as originally described. ... Therefore, the amendments to the claims introduce new matter and the applicant is required to cancel the new matter in the reply to this Office Action.

Contrary to the requirement of the Patent Office, Applicant is NOT required to cancel Applicant's patentable subject matter as a condition of the examination. [emphasis added] Requiring Applicant to cancel Applicant's patentable subject matter in reply to this Office Action is clearly prejudicial.

Final Rejection of 7/9/2009 stated:

1) Amendments to Specification

... The term "a composite material" as disclosed in the amendment would introduce new matter and change the description from "a candy bar" to "a composite material candy bar" in paragraph [0164], which is not the same as a

Appn. Number 09/641,410 (Kiely)

GAU 1794

Request for Reconsideration

5

generic term "candy bar" as originally described. Therefore, the amendments to the specification introduce new matter and the applicant is required to cancel the new matter in the reply to this Office Action.

2) 35 U.S.C. Section 112, first paragraph

In the instant case the term "composite material" as added to the claims introduces new matter as the term is not disclosed in the original disclosure and the introduction of the term "composite material" changes the description of "a candy bar" to "a composite material candy bar", which is not the same as a generic term "candy bar as originally described.

Applicant was again required to cancel Applicant's patentable subject matter. This is clearly unlawful and prejudicial. Applicant is NOT required to cancel Applicant's patentable subject matter in reply to the Office Action.

N.B. This prejudice has recently been conceded by the Patent and Trademark Office by the entry of Applicant's term "composite material" into the specification and the claims in dependent application SR No. 11/903,722, Method of Supporting a Comestible. (Final Rejection on 9/15/2010 - **Exhibit A**)

This is confirmation by the Patent and Trademark Office that the Office Actions of 10/16/2008 and 7/9/2009 were both indeed prejudicial. Thus, Application SR No. 09/641,410 was in fact never abandoned.

3) Election/Restriction

Since applicant had elected a product and not the method of making in response to the election requirement the method of making the product, i.e. claims 370-382 are withdrawn from consideration as being directed to a non-elected invention.

The withdrawal of Applicant's method and means claims by the Office was prejudicial and in

Appn. Number 09/641,410 (Kiely)

GAU 1794

Request for Reconsideration

6

direct conflict with the acknowledgment of such method claims and such means claims. These claims were examined by the Patent and Trademark Office, as is, in the first Office Action on the merits for Applicant's claims on 5/23/2003. As far as applicant is aware, the method and means claims are not to be withdrawn from examination without specific documented prima facie evidence of being patentably distinct, of which no evidence had ever been sent to Applicant.

According to the record, the Office Action of 7/9/2009 was also unjustly made final having introduced a new reference to Lane (1,690,984) which was not due to an amendment of applicant nor an IDS. (MPEP 706.07(a) "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.117(p))." (Page 8-9 of Petition of 12/16/2010). Authorities as to law and the MPEP may be relied upon by Applicant and MUST not be ignored.

35 U.S.C. Section 102

Claim 383 recites:

A non-frozen support for a frozen comestible comprising an edible confectionary material comprising two ingredient materials within said edible confectionary material or two constituent materials.

In the Office Action of 10/16/2008, claim 383 had been rejected on the ground of:

Musher teaches ice cream (frozen comestible) on an edible support structure or a composite support which has at least two edible discernable (i.e. perceptible) edible materials or components or members that are combined together to make the support, i.e., two combined ingredient materials. (Page 1; Column 1, lines 37-46 and Column 2 lines 40-55) also (Page 4: column 1, line 72 to Column 2, line 23 as instantly claimed.

Appn. Number 09/641,410 (Kiely)

GAU 1794

Request for Reconsideration

7

The Office wholly failed to consider Applicant's claims 349 - 382. The Office is aware of Applicant's subject matter of: "... material comprising two ingredient materials *within said* edible confectionary material" and said so:

"In fact, since the edible support is disclosed as being a composite, how can it be homogenous? The two are mutually inconsistent..." and

"In regard to claim 76, claim 76 can be construed to recite that the edible support comprises one or more elements a through m and particulate matter and a homogenous comestible." (Office Action - 5/23/03)

Claim 383 has been rejected based upon:

a ...composite support which has at least two materials or components or members that are combined together to make the support...

Claim 383 recites a ...material comprising two ingredient materials...

In the Office Action of 7/9/2009, claims 383-402 were rejected under section 102 on the ground:

Regarding claims 383 and 394 Musher teaches ice cream (frozen comestible) on a non-frozen edible support structure or a composite support which has at least two edible discernable (i.e. perceptible) edible confectionary materials or components that are combined together to make the support, i.e., two constituent ingredient materials (Page 1: Column 1, lines 37-46 and Column 2 lines 40-55), as instantly claimed.

The Office wholly failed to consider Applicant's claims 383 - 416.

Applicant is not required to beg the Office to provide a full and fair examination. Of its own volition, the Office chose to continually and intentionally ignore the merits of all claims in order to deny Applicant ground upon which to stand. The Office has not demonstrated a prima facie case of anticipation of claims 383 - 416 under section 102. Under the Policy of Compact Prosecution, the Office's opportunities to provide a prima facie case have long since expired. (MPEP 707.07(g))

Appn. Number 09/641,410 (Kiely)

GAU 1794

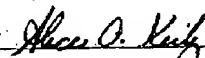
Request for Reconsideration

8

As above, it is respectfully submitted that at least both Office Actions for which Applicant had paid and was entitled to a full and fair examination were both prejudicial in nature. Thus, the finality of the Office Action was ineffectual and the abandonment of the application never factually existed.

Applicant respectfully requests reconsideration and the withdrawal of the holding of abandonment of Application Serial Number 09/641,410, Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards.

Very Respectfully,


Alice O. Kiely

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Certificate of Facsimile: I certify that on the date below, this document and referenced attachments, if any, will be faxed to the central fax number of 571-273-8300 to the United States Patent and Trademark Office "Commissioner for Patents" Arlington, Virginia 22313.

2011 May 5,


Alice O. Kiely

Attached:

Exhibit A - SR NO. 11/903,722 Method of Supporting a Comestible, page 2, Amendments to Specification: entry of the term "composite material" into specification and claims by the PTO.

Exhibit A

09/641,410

GAU 1794

5/5/2011

KIELY

pg. 7

Application/Control Number: 11/903,722

Page 2

Art Unit: 1781

9/15/2010

DETAILED ACTION

Applicant's submission filed on 6/24/2010 has been entered. Claims 53-78 have been added to the current application. Claims 54, 59-62, 65-71, 73-74, and 76-78 have been amended by the applicant. Claims 53-78 are pending and examined in the current application.

Amendments to Specification

The amendments to specification filed by the applicant on 6/24/2010 have been received which add proposed term "material" in paragraphs [0044], [0045], [0165], and correct a typographical error and replacing "caramel on top of the caramel" with "caramel on top of the cookie caramel" in paragraph [0197]. The "composite material" was part of claim 6 of parent application 09/641410 submitted on 8/18/2000 and thus regarded as part of original disclosure of the parent application. Therefore, the amendments do not introduce any new matter and have been entered.

Claim Objections

Claims 53-78 are once again objected to because of the following informalities: base claims 53, 63, and 72, line 1, have a typographical error as the claim recites the term "comprising" twice. Appropriate correction is required.

Claims 60, 69, and 76 is also objected for the recitation of "comprising" twice in line 2 of each of the claims. Appropriate correction is required.